

## **REMARKS/ARGUMENTS**

In the Office Action mailed July 7, 2009, claims 1-18 were rejected. In response, Applicants hereby request reconsideration of the application in view of the following amendments and remarks. No claims are canceled.

For reference, claims 1, 7, and 13 are amended to clarify the language of the claims. In particular, claim 1 is amended to recite the digitally-signed privacy-use information is obtained separate from a business transaction between participants. Claim 1 is also amended to clarify that the sharing allows the participants to verify that the digitally-signed privacy-use information has not been tampered with. Claims 7 and 13 are amended to recite similar language. The language of these amendments is supported, for example, by the subject matter described in the specification at page 10, lines 3-7 (“the digitally signed privacy policy is submitted to the E-marketplace [which] stores the digitally signed privacy policy for use at the appropriate time in subsequent transactions.”).

Additionally, claims 19 and 20 are added. In particular, claim 19 is added to recite the E-marketplace sending the digitally-signed privacy-use information of a potential business partner to a buyer in conjunction with the buyer requesting information regarding the potential business partner, prior to the buyer selecting to do business with the potential business partner. Claim 20 is added to recite the E-marketplace sending the digitally-signed privacy-use information of a business partner to a buyer after the buyer selects to do business with the business partner. The language of these claims is supported, for example, by the subject matter described in the specification at page 10, lines 8-17, of the present application.

### References to Dictionary Definitions

Applicants notes that the Office Action refers to certain dictionary definitions within the body of the Office Action. While the Office Action may refer to dictionary definitions for a contextual understanding of the art, generally, it should be understood that the use of certain dictionary definitions in the Office Action remarks does not define the scope of the claims. Rather, the language of the claims themselves sets out the scope

of the claims. Thus, the claim language should be viewed in light of the exact language of the claim, instead of any particular dictionary definitions referenced in the Office Action.

#### Claim Rejections under 35 U.S.C. 103

Claims 1-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Barzilai et al. (U.S. Pat. Pub. No. 2002/0029201, hereinafter Barzilai) in view of Bowman-Amuah (U.S. Pat. No. 6,697,824, hereinafter Bowman). However, Applicants respectfully assert that these claims are patentable over Barzilai and Bowman for the reasons provided below.

#### Independent Claim 1

The rejection of claim 1 is improper because the Office Action does not establish a *prima facie* rejection of the claim. Also, claim 1 is patentable over the combination of Barzilai and Bowman because this combination fails to teach all of the limitations of the claim. Claim 1 recites:

A computer-implemented method of conducting electronic commerce transactions among a plurality of participants in an E-marketplace, comprising the steps of:

the E-marketplace obtaining, via a computer, digitally-signed privacy-use information for each participant, wherein the digitally-signed privacy-use information is obtained separate from a business transaction between participants; and

the E-marketplace sharing, via said computer, the digitally-signed privacy-use information with any participants interested in doing business with each other in the E-marketplace, wherein the sharing allows the participants to verify that the digitally-signed privacy-use information has not been tampered with since being submitted to the E-marketplace.

(Emphasis added.)

##### 1. The Office Action does not establish a *prima facie* rejection of claim 1.

The rejection of claim 1 is improper because the Office Action does not establish a *prima facie* rejection of claim 1. In order to establish a *prima facie* rejection of a claim under 35 U.S.C. 103, the Office Action must present a clear articulation of the reason why the claimed invention would have been obvious. MPEP 2142 (citing *KSR*

*International Co. v. Teleflex Inc.*, 550 U.S. \_\_ (2007)). The analysis must be made explicit. *Id.* Additionally, rejections based on obviousness cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

Here, the Office Action fails to explain why the limitations of claim 1 would have been obvious because the Office Action does not acknowledge the actual language of claim 1. In particular, the Office Action fails to acknowledge that claim 1 recites participants may “verify that the digitally-signed privacy-use information has not been tampered with since being submitted to the E-marketplace” (emphasis added). In fact, the Office Action does not even make an assertion that the cited references might describe the indicated limitation, or that the indicated limitation might otherwise be obvious in light of the cited references. Moreover, the amendments presented to clarify the context of the indicated language do not negate the applicability of this traversal argument.

Therefore, the Office fails to establish a *prima facie* rejection for claim 1 because the Office Action does not assert or show how the cited references might teach allowing a participant to “verify that the digitally-signed privacy-use information has not been tampered with since being submitted to the E-marketplace,” according to the language of the claim. Therefore, Applicants respectfully assert that the rejection of claim 1 under 35 U.S.C. 103(a) is improper because the Office Action does not establish a *prima facie* rejection of the claim.

2.     The combination of Barzilai and Bowman fails to teach all of the limitations of the claim.

Moreover, the combination of cited references does not teach all of the limitations of the claim because neither Barzilai nor Bowman teaches an E-marketplace which obtains digitally-signed privacy-use information separate from a business transaction between participants. In particular, Barzilai makes no mention of tampering with privacy-use information, or any type of anti-tampering features. As recognized in the Office Action, Barzilai does not describe using a digital signature. Office Action, 7/7/09, page 4. Hence, the rejection in the Office Action relies on Bowman as purportedly

teaching an e-Commerce environment in which information is digitally signed. However, Bowman fails to teach the indicated limitation.

Although the reasoning in the Office Action refers to a description in Bowman in which a message digest may include a digital signature (col. 68, lines 20-27), Bowman teaches that the message digest is attached to data prior to transmission (col. 68, lines 6-11). Bowman does not appear to specifically describe what kind of data the message digest is attached to, but the context of the description appears to indicate that the message digest is attached to data transactions between participants on an e-Commerce system. Regardless, the lack of teaching regarding the type of data to which the message digest might be attached is nevertheless insufficient to teach obtaining digitally-signed privacy-use information separate from a business transaction between participants.

For the reasons presented above, the combination of Bowman and Barzilai does not teach all of the limitations of the claim at least because Barzilai does not teach obtaining digitally-signed privacy-use information separate from a business transaction between participants, as recited in the claim. Accordingly, Applicants respectfully assert claim 1 is patentable over the combination of Bowman and Barzilai because the combination of Bowman and Barzilai does not teach all of the limitations of the claim.

#### Independent Claims 7 and 13

Applicants respectfully assert independent claims 7 and 13 are patentable over the proposed combination of cited references at least for similar reasons to those stated above in regard to the rejection of independent claim 1. Each of these claims recites subject matter which is similar to the subject matter of claim 1 discussed above. Although the language of these claims differs from the language of claim 1, and the scope of these claims should be interpreted independently of other claims, Applicants respectfully assert that the remarks provided above in regard to the rejection of claim 1 also apply to the rejections of these claims.

#### Dependent Claims

Claims 2-6, 8-12, and 14-18 depend from and incorporate all of the limitations of the corresponding independent claims 1, 7, and 13. Applicants respectfully assert that

claims 2-6, 8-12, and 14-18 are allowable based on allowable base claims. Additionally, each of claims 2-6, 8-12, and 14-18 may be allowable for further reasons.

### CONCLUSION

Applicants respectfully request reconsideration of the claims in view of the amendments and the remarks made herein. A notice of allowance is earnestly solicited.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account **09-0461** pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees to Deposit Account **09-0461** under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Respectfully submitted,  
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